

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RUTH LIPMAN

Appeal No. 2005-0124
Application No. 10/035,305

ON BRIEF

WILLIAM F. SMITH, ELLIS and GREEN, Administrative Patent Judges.

ELLIS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4 and 6-12. Claims 5 and 13-20 have been withdrawn from consideration. 37 C.F.R. § 1.142.

In addition, we note that in response to an election of species requirement set forth by the examiner, the appellant elected to prosecute onion plants from the genus and species Allium cepa, and the extract lecithin. We have limited our consideration of the issues accordingly.

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As a preliminary matter, we find that the appellant states that the claims stand or fall together. Brief, p. 4. However, the appellant separately argues claims 3 and 9. Accordingly, for purposes of this appeal, we have considered the issues as they apply to representative claims 1, 3 and 9, which read as follows:

1. A method, comprising:

extracting a plant of an Alliacease family, Allium genus; and

applying the extract to an exposed surface of a plant to repel animals, wherein an animal feeding on the plant is repelled.

2. The method of claim 1, wherein the Allium genus includes Allium Cepa.

3. The method of claim 2, wherein the Allium Cepa is selected from the group consisting of White Lisbon, Southport White Globe, Southport Red Globe, White Spanish Bunching, White Knight, Red Creole, Red Burgundy, Red Grano, Red Granex and combinations thereof.

9. The method of claim 1, wherein the extract further comprises alliinase enzyme.

The references relied upon by the examiner are:

Messina	4,965,070	Oct. 23, 1990
King	5,417,973	May 23, 1995
Sasaki	62-297838	June 1, 1989

The claims stand rejected as follows:

I. Claims 1-4 and 6-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Messina.

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II. Claims 1-3, 7, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Messina.

We affirm.

Background and Discussion

As indicated by the claims above, the subject matter on appeal is directed to a method of applying an extract derived from an onion plant of the genus Allium on the surface of a plant such that said extract will repel an animal feeding thereon.

Rejection I

The examiner argues that the claimed invention would have been obvious to one of ordinary skill in the art in view of the teachings of King with respect to a method of repelling animals using an onion extract derived from the genus Allium. Answer, p. 3. The examiner acknowledges that King teaches the use of an onion extract to repel animals from carcasses, but argues that such persons would have understood that the repellent could be used to repel animals from any surface. Id. The examiner further acknowledges that King does not teach the varieties of onion recited in claim 3, but she points out that the appellant's specification discloses that said varieties are known varieties of Allium cepa. Id. Therefore, the examiner concludes that it would have been obvious to one of ordinary skill in the art to use any of the known onion varieties of the genus and species disclosed by King.

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In addition, the examiner relies on the teachings of Messina that eggs (which contain lecithin) are added to animal repellants as a deterrent agent. Answer, p. 4. Thus, the examiner concludes it would have been further obvious to one of ordinary skill in the art to add egg to the repellent taught by King.

It is well established that the examiner has the initial burden under § 103 to establish a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

As discussed above, the claims stand or fall together with representative claims 1, 3 and 9. Since we limit our consideration of the issues as applied to these claims, we find that the King patent alone is sufficient to establish a prima facie case of obviousness. That is, because none of the aforementioned claims is directed to an extract containing lecithin, we need not reach the teachings of the Messina patent to affirm the rejection.

Claims 1 and 9

Here, we find that King discloses a method of making an extract from a plant of the Alliaceae family, Allium genus (specifically, Allium cepa) and the application of said extract to animal carcasses such that said application repels animals feeding on the meat. King, col. 1, lines 6-9, 43-46, 54-60; col. 3, lines 3-4. Thus, we find that the only difference between the method described in claims 1 and 9 and the method taught by

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the prior art is that the King patent teaches the application of the extract to a different surface. That is, King teaches the application of the Allium cepa extract to an animal carcass, instead of a plant. We do not find that the application of the extract to another surface imparts any new properties to said extract. Rather, we find that regardless of whether the Allium cepa extract taught by King is applied to a plant, animal carcass, garbage can, etc., it will still repel animals. Accordingly, we conclude that the teachings of King would have reasonably suggested, to one of ordinary skill in the art, the method of applying an Allium cepa extract to a plant as described in representative claims 1 and 9. In our view, the appellant is merely claiming a new benefit for an old process, i.e., a process (method) of repelling animals using an extract of Allium cepa. Cf.¹ In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 632-33, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987).

The appellant argues that the examiner's use of the Messina patent to modify the teachings of King is improper because the former is directed to repelling deer from

¹ We point out that "cf." is an abbreviated form of the Latin word, confer, meaning "compare." It is widely used in the legal field to cite an authority which supports a proposition different from the main proposition but sufficiently analogous to lend support. The Bluebook, A Uniform System of Citation, 17th Edition, Harvard Law Review Association, Cambridge, 2000, p. 23.

plants and the latter to repelling pests from an animal carcass.² Brief, p. 5. According to the appellant, the modification of King by replacing the animal carcass with the plant taught by Messina "would destroy the teaching of [King]" which "requires 'preserving and preventing pest damage to an animal carcass or skin.'" Id. In addition, the appellant contends that King does not "teach or suggest placing a plant on the animal carcass for any purpose." Id. We find these arguments unpersuasive.

As discussed above, we find no reason to combine the King and Messina references to arrive at the inventions described in representative claims 1 and 9. Accordingly, the appellant's arguments in this regard are moot.

With respect to claim 9, the appellant argues that King does not teach or suggest an extract which comprises the alliinase enzyme. Brief, p. 7. We disagree. As pointed out by the examiner, the specification discloses (page 10) that it was known in the art that the referenced enzyme is a component of the odors associated with onion. Accordingly, we find that one of ordinary skill in the art would have understood that the Allium cepa extract taught by King contains said enzyme.

² According to the appellant, pests taught by King are insects and birds. Brief, p. 5. We disagree. Attention is directed to col. 1, lines 19-23 wherein King states that pests include animals such as cats and dogs. See also, King, col. 2, line 40.

Claim 3

With respect to claim 3, the appellant argues that King does not teach or suggest each and every feature of claim 3. Brief, p. 6. We disagree. We find that King teaches that extracts of the various varieties of Allium cepa are preferred agents to use in the disclosed method of repelling animals (col. 3, lines 3-7). As pointed out by the examiner, the specification teaches that the varieties listed in claim 3 are simply different varieties of Allium cepa available in the art. See the specification, p. 4. Accordingly, we hold that it would have been obvious to one of ordinary skill in the art to employ any known Allium cepa variety to repel animals.

We disagree with the appellant's argument in the reply brief that the examiner has raised a new ground of rejection in the Answer. The examiner's statements with respect to hot pepper and onion extracts being functional equivalents were made in response to the appellant's argument. See the Answer, pp. 5-6. In any event, we did not consider the examiner's arguments in this regard in reaching our conclusion that the invention described in representative claims 1, 3 and 9 would have been obvious to one of ordinary skill in the art over the teachings of King. Accordingly, the appellant's argument in this regard is moot.

Rejection II

The examiner argues that the subject matter set forth in claims 1-3, 7, 11 and 12 would have been obvious to one of ordinary skill in the art in view of the combined teachings of Sasaki and Messina. Answer, p. 4. However, having already concluded that the aforementioned subject matter would have been obvious in view of King, we need not determine whether it would have been further obvious in view of additional references. Accordingly, we have not considered the merits of Rejection II.

Response to the Dissent

If one follows the dissent's reasoning through to its logical conclusion, it would be necessary to find a new reference for each surface on which the onion extract taught by King is applied in order to establish a prima facie case of obviousness. That is, the dissent believes that it would not have been obvious to one having ordinary skill in the art to apply the onion extract to different household or garden items and, therefore, the method of applying the extract to each item constitutes a patentably distinct invention. We respectfully disagree.

In our view the dissent has neglected two criteria important in making a determination of obviousness.

First, what is the claimed invention? As indicated by claim 1, above, the invention is directed to a method of repelling animals from plants using an onion extract

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of the Allium genus. It is not directed to a method of repelling insects and birds from said plants, nor does it require the repulsion of a specific animal type. Thus, there is no need for King to suggest that plants need to be protected from "blow flies, flies, gnats, yellow jackets, cats, dogs and birds." Rather, King needs only to suggest the aforementioned extract for repelling any animal to those having ordinary skill in the art.

Second, what would one of ordinary skill in the art understand from the teachings of King? In re Kotzab, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) ("The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved"). This has been answered by the dissent. That is, the dissent acknowledges that King discloses the use of an onion extract (of the Allium genus) to repel "blowflies,' flies, gnats, jellow [sic, yellow] jackets, cats, dogs, birds (e.g. ('camp robbers') and other pests" (dissent, page 1) from an animal carcass. Stated otherwise, King discloses the use of the onion extract to repel insects, animals and birds. Thus, in our view, King would have suggested to one skilled in the art that the onion extract taught therein is a powerful broad-spectrum repellent capable of repelling insects, animals and birds from a highly desirable target. As discussed above, we find that said person when confronted with the problem of needing to repel any of the aforementioned from any object, be it an

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animal carcass,³ plant, garbage can, chair, etc., etc., would have understood that said repellent would repel the aforementioned therefrom. Accordingly, we conclude that given the teachings of King, it would have been obvious to one having ordinary skill in the art to use said repellent to repel animals from any surface.

Finally, we do not disagree that there could be other references which the examiner might have found and applied in combination with King, or even alone. That is not the issue. The obviousness of applying the claimed extract to a surface other than that taught by the applied prior art is well within the reasoning capability of one having ordinary skill in the art. Moreover, the examiner needs only to establish a prima facie case of obviousness. The dissent's, and similar references, do not alter the reasonableness of the examiner's rejection. Accordingly, there is no reason to reverse the rejection simply because there may be additional references available.

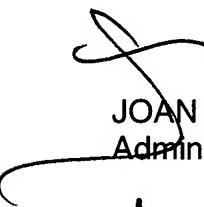
In view of the foregoing, the decision of the examiner is affirmed.

³ We point out that King also discloses using the onion extract to repel animals from fish. See, col. 1, lines 17-18; col. 2, lines 32-35.

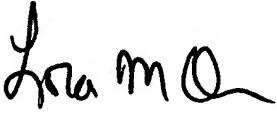
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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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JOAN ELLIS
Administrative Patent Judge

 Lora M. Green

LORA GREEN
Administrative Patent Judge

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William F. Smith, Administrative Patent Judge, dissenting:

I respectfully dissent from the majority's affirmance of the examiner's rejection of claims 1-4 and 6-12 under 35 U.S.C. § 103(a) based upon King.

Claim 1 is not difficult to understand. To put the claim in English rather than Latin, claim 1 is directed to a method which comprises extracting an onion and applying the onion extract to an exposed surface of a plant to repel animals wherein an animal feeding on the plant is repelled. The sole reference relied upon by the majority in affirming the rejection is King.⁴ In relevant part, King applies a repelling agent which can include onion extract to an animal carcass. King, column 1, lines 54-60. King applies the extract to the carcass because, during a cooling process, "the meat is susceptible to attack by 'blowflies,' flies, gnats, jellow jackets, cats, dogs, birds (e.g. 'camp robbers') and other pests. These pests can eat substantial portions of the meat (e.g. cats), or can lay eggs on it (e.g. flies)." Id., column 1, lines 19-23. Both the examiner and the majority agree that King does not teach applying the onion containing extract of that reference to a plant.

The examiner has concluded that "a person of ordinary skill in the art would recognize that the repellent composition taught by [King] could be used to repel animals from any surface that is known to be at risk for animal damage." Examiner's Answer,

⁴ The majority states that they "find no reason to combine the King and Messina references." Slip opinion, page 6. Thus the majority's affirmance rests upon King alone.

page 3. Notably missing from the examiner's fact finding is any determination that plants constitute a surface upon which any of the pests described in King would find appetizing. In other words, the examiner has not determined as a factual matter in this record that plants are susceptible to feeding by blowflies, flies, gnats, yellow jackets, cats, dogs, and birds.

In similar fashion, the majority eschews making a finding of fact that plants were known at the time of the present invention to be fed upon by any of the pests enumerated in King. Rather, the majority takes an approach that is different from the examiner's, stating "we do not find that the application of the extract to another surface imparts any new properties to said extract." Slip opinion, page 5.

In my view, the majority is putting the cart before the horse. The question of obviousness to be resolved in this appeal is not whether applying appellant's onion extract to a plant surface "imparts any new properties to said extract." Rather, the question to be answered is whether King in and of itself, since this is the only evidence relied upon by the majority, would have taught or suggested the use of an onion containing extract to plants to repel animals that would otherwise feed upon the plant.

In my view, if claim 1 is to be considered to have been obvious from a consideration of King by itself, one must be able to make the finding that at the time of the present invention a person of ordinary skill in the art would have known that plants needed to be protected from blow flies, flies, gnats, yellow jackets, cats, dogs, and birds. Absent such a finding I do not see that King itself suggests applying the onion

extract of that reference to any other object or surface. While one may think that it is “well known” or “common sense” that cats, dogs, and birds may eat certain plants, the fact remains that neither the examiner nor the majority have favored the record with a finding in this regard.

We have been constantly reminded in recent years by our appellate reviewing court that a conclusion of obviousness must be grounded upon facts found in the record. Here, the need to protect plants from blow flies, flies, gnats, yellow jackets, cats, dogs, and birds, the pests enumerated in King, constitutes a core factual finding that must underpin a conclusion of obviousness. However, neither the examiner nor the majority have made a finding in this regard. As stated in In re Zurko, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), “the board must point to some concrete evidence in the record” to support such a finding, rather than rely upon our assessment of what is “well recognized” or what a skilled artisan would be “well aware.” Furthermore, facts relied upon in reaching a conclusion of obviousness cannot be based upon “subjective belief and unknown authority.” In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

In In re Thrift, 63 USPQ2d 2002, 298 F.3d 1357 (Fed. Cir. 2002), the court reversed the Board’s affirmation of the examiner’s rejection of claim 11 stating that the Board’s decision is “not supported by substantial evidence because the cited references do not support each limitation of claim 11.” Id., at 2008, 298 F.3d at 1366. I challenge the majority to point to any teaching in King that describes the application of

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an onion extract to a plant for any purpose let alone to protect the plant from predation by animals. Absent such a teaching, the examiner's and the majority's conclusion of obviousness does not rest upon substantial evidence.

Furthermore, the majority exacerbate their error by citing In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) and Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 632-33, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987) for the proposition that claiming a new benefit for an old process is not patentable. The majority is correct that that principle is discussed in each of those cases but it is discussed in the context of 35 U.S.C. § 102, anticipation, not 35 U.S.C. § 103, obviousness. The rejection under review in Woodruff was under 35 U.S.C. § 103. However, the court stated “[w]hile the processes encompassed by the claims are not entirely old, the rule is applicable here to the extent that the claims and the prior art overlap.” Woodruff, 919 F.2d at 1578, 16 USPQ2d at 1936.

I fully understand the meaning of the legal signal cf.. What I do not understand is what proposition that differs from the proposition set forth in these cases but is allegedly “sufficiently analogous to lend support” the majority relies upon since they have not articulated any. Slip opinion, n. 1. Again the two cited cases are relevant to an anticipation rejection not an obviousness inquiry, as here. Neither the examiner nor the majority have established that any method required by claim 1 on appeal is subsumed by the disclosure of King. The majority's reliance upon this legal principle and the two cited cases is misplaced.

The majority state that my reasoning would necessitate a new reference for each surface on which the onion extract taught by King is applied to establish a prima facie case of obviousness. Slip opinion, page 8. Since King only describes applying the extract to an animal carcass, some evidence must be relied upon in order to conclude that it would have been obvious to one of ordinary skill in the art to use the onion extract on a surface other than an animal carcass. Rather than rely upon evidence, the majority relies upon the skill of the art to extend the teachings of King to plants. In so doing the majority does not discuss or in any other way come to grips with Zurko, Lee, and Thrift and the lessons taught in those cases regarding the pitfalls of relying upon the skill of the art as opposed to evidence of record to support a conclusion of obviousness. It is improper to rely upon “skill in the art” to support a core factual finding when concluding a claim would have been obvious as the majority does here.

The wayward nature of the majority’s position is also seen in their statement that a “person [] confronted with the problem of needing to repel any of the [pests listed in King] from any object ... would have understood that said repellent would repel the [King pests] therefrom.” Slip opinion, pages 9-10. I also note the majority’s statement that “King needs only to suggest the aforementioned extract for repelling any animal to those having ordinary skill in the art.” Slip opinion, page 9. This last statement loses sight of the subject matter of claim 1 that requires application of the extract to a plant surface. Claim 1 is not directed to repelling animals from surfaces in general. Thus, a suggestion specific to plant surfaces is needed, not the general suggestion sought by

the majority. Reading King by itself, as we must, where does King suggest that the extract be applied to plants? That suggestion is seen only if one understands that plants are fed upon by any of the pests enumerated in King. The examiner and the majority fail to point to any teaching in King that is relevant to protecting plant surfaces from feeding animals, let alone the pests set forth in King.

I also note the majority sets forth a new test of obviousness, i.e., obviousness can be based at least in part on the "reasoning capability of one having ordinary skill in the art." Slip opinion, page 10. Again, the majority does not cite any authority for this statement. It is unclear how this new "reasoning capability" standard comports with the need to rely upon record evidence as set forth in Zurko, Lee, and Thrift.

In the final analysis, this whole case may be much ado about nothing. I found a reference by way of searching the internet for ten minutes, i.e., the May/June 2001 issue of the "Connecticut Gardener." A copy of the information available at URL <http://www.conngardener.com/samples/article3.html> as accessed on February 9, 2005 is attached. As seen from the copy, the original "Recipe for Deer and Vole Repellent" was first published in September/October of 1999. The repellent described includes eggs, garlic, fresh green onion tops, and water. Alternatively, the recipe can include "regular onions." The repellent may be poured down a vole hole in order to repel voles from attacking plant material or "flicked around," presumably a yard or garden, in order to keep deer away. As seen, this reference describes the use of onion extract on plants in order to repel animals from feeding on the plants.

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In the event of further prosecution, appellant and the examiner should take the "Connecticut Gardener" reference into account as well as perform their own independent search on the internet. It is believed that such a search will reveal numerous citations of the common act of planting onions around an area of a garden or yard in order to deter deer from browsing therein. In other words, there is evidence outside of the record in this appeal to support a conclusion that the subject matter of claim 1 would have been obvious. It is the responsibility of the examiner to find such evidence in the first instance and rely upon it in rejecting claim 1.

I am not suggesting that the examiner's rejection be reversed because other prior art is available. Slip opinion, page 10. I would reverse the examiner's rejection because it is not supported by the record evidence. While there may be evidence outside of the present record to support a finding that claim 1 on appeal would have been obvious to a person of ordinary skill in the art, the fact remains that neither the examiner nor the majority rely upon such evidence in support of their conclusion of obviousness. Accordingly, I dissent.


William F. Smith
Administrative Patent Judge

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